

### **REMARKS**

Applicant has received and reviewed the Final Office Action dated February 27, 2007, and submits this response to the Final Action.

Claims 1, 3, 11, 13, 19, and 21-23 are pending in the present application. Applicant amends independent Claims 1, 11, and 19 by deleting text to clarify claimed subject matter and/or correct informalities. Therefore, these revisions introduce no new matter.

**Claims 1, 3, 11, 13, 19, and 21-23** are pending for consideration upon entry of the present amendment. Claims 4-10 and 14-18 have been withdrawn, but depend from independent Claims 1 and 11, which are in allowable form after this response. In view of the following remarks, Applicant respectfully requests rejoinder of the withdrawn claims, reconsideration, and allowance of the subject application.

#### **Claim Rejections 35 U.S.C. §112, 1<sup>st</sup> and 2<sup>nd</sup> paragraphs**

**A. Claims 1, 3, 11, 13, 19, and 21-23 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.**

**B. Claims 1, 3, 11, 13, 19, and 21-23 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement.**

**C. Claims 1, 3, 11, 19, and 21-23 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.**

Applicant respectfully traverses these rejections.

Without conceding the propriety of the stated rejections, and only to advance the prosecution of this application, Applicant has deleted text from **independent Claim 1**, to obviate the rejection. **Independent Claim 1** now recites a fish tape, comprising:

a longitudinal portion comprising a circular outer diameter, and defining a solid substantially cylindrical shape along the longitudinal portion of the fish tape, wherein the solid substantially cylindrical shape comprises a plurality of spiral grooves defined along the circular outer diameter and extending along the longitudinal portion;

wherein the longitudinal portion of the fish tape comprising the plurality of spiral grooves and the plurality of spiral grooves allow the fish tape to substantially flex in at least one vertical direction and in at least one horizontal direction relative to an axis of the cylindrical shape; and

an end portion comprising a groove extending from the end portion at least partially along the longitudinal portion.

First, the Office states that there is no support in the original disclosure for the end groove 53 of Figure 5 to be combined with the Figure 8 embodiment that has a spiral groove (Office Action, pg. 2). Applicant respectfully disagrees. Applicant directs the Office to the original specification to show support that the end groove of Figure 5 can be combined with the embodiment of Figure 8. The original specification recites, "**the end portion** 51 comprising the grooves 53 of Figure 5 can be fixedly attached to an end portion of the fish tape 36, 60, 70, **80**, 90, 100" (Specification, para. [0023]). The fish tape 80 is the embodiment of Figure 8. Thus, there is explicit support for this claimed feature in the original disclosure.

Next, the Office states that the claim recitation of “spiral groove” and “end portion groove” are new matter. Applicant points out that the claim language recites “end portion”, which is supported in the specification (Specification, para. [0023]). The recitation “spiral groove” may be found at least at paragraph [0017], and is shown in Figures 8 and 8A. Thus, there is no new matter.

Furthermore, the Office states that the use of groove 53 is inadequately disclosed. Applicant respectfully disagrees. Applicant directs the Office to paragraph [0023] of the original specification, which is reproduced below for convenience.

**Specification, para. [0023]:**

For example, any of the fish tape 36, 60, 70, **80**, 90, 100 embodiments include **an end portion 51 including a plurality of grooves 53 about a diameter extending partially along the longitudinal axis 55** of the fish tape 36, 60, 70, **80**, 90, 100. The end portion 51 comprising the grooves 53 can be fixedly attached to the an end portion of the fist tape, 36, 60, 70, **80**, 90, 100 or it can be formed integrally therewith. As discussed previously, the grooves 53 provides a mechanism for attaching a plurality of wire or cable engaging attachments to the end portion 51 of the fish tape 36, 60, 70, **80**, 90, 100.

As shown in the original specification, there is adequate disclosure describing how the end portion 51 comprises the grooves 53 and provides a mechanism for attaching a plurality of wire or cable engaging attachments to the end portion. Nevertheless, Applicant deletes the text from the claims to obviate the rejections. Furthermore, there is adequate disclosure that the groove of Figure 5 can be used with a fish tape having the continuous groove of Figure 8. Applicant respectfully requests the withdrawal of this rejection.

Lastly, the Office states that “it is not understood how the end groove 53 interacts with the spiral groove”. Applicant directs the Office to the remarks and the citations from the original specification, provided above. Thus, it is explained how the end groove 53 interacts with the spiral groove. Therefore, Applicant respectfully requests that the §112 rejections be withdrawn.

**Independent Claims 11 and 19** are directed to a fish tape device and a fish tape, respectively, and each is allowable for reasons similar to those discussed above with respect to Claim 1.

**Dependent Claims 3, 13, and 21-23** depend directly or indirectly from one of independent Claims 1, 11, and 19, respectively, and are allowable by virtue of this dependency. Applicant respectfully submits that these claims now comply with 35 U.S.C. §112, first paragraph and second paragraph, and requests that the §112 rejections be withdrawn.

#### **Rejoinder of Withdrawn Claims**

Applicant requests rejoinder of the non-elected claims. Claims 4-10 and 14-18 stand withdrawn as being directed to a non-elected species. However, Claims 4-10 and 11-18 depend from base claims, which are in allowable form, and should therefore be rejoined (see MPEP 821.04). Applicant respectfully requests rejoinder of the non-elected claims, Claims 4-10 and 14-18.

**Conclusion**

Claims 1, 3, 11, 13, 19, and 21-23 are in condition for allowance. Applicant respectfully requests rejoinder of the withdrawn claims, reconsideration, and allowance of the subject application. If any issue remains unresolved that would prevent allowance of this case, the Office is requested to contact the undersigned attorney to resolve the issue.

Respectfully Submitted,

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